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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,694	12/01/2003	Neil C. Young	019491-004610US	2546
58201                      7590                      01/18/2011 TOWNSEND AND TOWNSEND AND CREW LLP/EA TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111				
EXAMINER RUSSELL, MATTHEW S				
ART UNIT		PAPER NUMBER		
3716				
MAIL DATE		DELIVERY MODE		
01/18/2011		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/725,694

Applicant(s)

YOUNG ET AL

Examiner

MATTHEW RUSSELL

Art Unit

3716

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-13, 17-24, 42-44, 47-53 and 55-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-4, 7-13, 17-24, 42-44, 47-53 and 55-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Introduction***

This office action is in response to the Applicants Arguments/Remarks dated 11/15/2010. Claims 1-4, 7-13, 17-24, 42-44, 47-53, and 55-58 are currently pending in this application.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 7, 42-43, 47 and 49-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,554,707 to Sinclair et al. (*Sinclair*) in view of US Patent 6,614,804 to McFadden et al. (*McFadden*).

4. *Sinclair* discloses a method for delivering content comprising a storyline for an electronic game (abstract, 1:49- 2:50, 4:30-38, 6:11-17:19) from a content server (310, 508, 510) to at least one user computer in a network (306) of connected user computers (abstract, 1:49-2:50, figs 1-19), the method comprising all features including deconstructing a complete storyline content into a plurality of episodes (abstract, 1:49- 2:50, 4:30-38, 6:11-17:19, figs 1-19 esp. 6-18); constructing a plurality of episodes to relate a complete storyline content (abstract, 1:49-2:50, 4:30-38, 6:11-17:19, figs 1- 19 esp. 6-18); implementing in the content server one or more/plurality of said episodes into one or more/plurality corresponding episodic game modules (abstract, 1:49-2:50, 4:30-38, 6:11-17:19, figs 1-19, ref 1708); providing/transmitting a first episodic game module to at least one user computer such that only a first portion of the complete storyline content is currently available (abstract, 1:49-2:50, 4:30-38, 6:11-17:19, figs 1- 19, ref 1708, i.e. game state dependent); altering, in the content server, a subsequent portion/remaining of the storyline content to include a game-related reference to a current real-world event, said current event occurring after said first episodic game module is provided to the at least one user computer abstract, 1:49-2:50, 3:44-4:38, 6:11-17:19, esp. 4:11-22, 13:45-15:27, figs 1-19); and providing the reference to at least one user computer after at least one user computer accesses the first episodic game module (abstract, 1:49-2:50, 3:44-4:38, 6:11-17:19, esp. 4:11-22, 13:45-15:27, figs 1- 19); implementing a second episode into an episodic game module (supra) and providing the second game module to at least one user computer including reference to the real-world event (abstract, 1:49-2:50, 4:30-38, 6:11-17:19, esp. 13:45- 15:27, user

profiling and seek/obtain clue in real world, figs 1-19, ref 1708-1799), wherein providing includes transmitting from content server to at least one user over network or on a computer readable medium readable by the at least one computer wherein reference is provided to at least one computer using a network transport mechanism such as voice mail (abstract, 1:49- 2:50, 4:30-38, 6:11-19:43, figs 1-19).

5. However, *Sinclair* fails to expressly disclose generating a technology module and a content module and to allow modification of the technology module independently from modification of the content of said at least one episodic game module.

6. McFadden teaches sending generated content data (content modules; Figs. 1, 3a/3b – 8, abst, col. 1:5-16; col. 2:20 – 3:25, col. 5:40-58, content data is text, html, video, etc..) and software update data (technology modules; Figs. 1, 3a/3b – 8, abst, col. 1:5-16; col. 2:20 – 3:25) from a server (12) to a computer (24) in a network system (fig 1, 3a/3b) ,like that taught by *Sinclair* (See *Sinclair*, abst, figs 1-5, server/computer network system). Further, *McFadden* teaches that the content and software data can be sent and updated concurrently or at different times, i.e. independent modification of technology and content modules (Figs. 1, 3a/3b – 8, abst, col. 1:5-16; col. 2:20 – 3:25, col. 4:65-6:25, col 6:45-58).

7. Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention to modify the game modules of *Sinclair* to include independent software update data (technology modules) and content data (content modules), as that taught by *McFadden*, for the purpose of more efficient use of the transmission link and updating the client software for operational enhancements as well as video program or

content enhancements as they come out (*See McFadden*; abst, col. 2:41-3:25).

Because, *McFadden* teaches that content providing systems, like that taught by *Sinclair*, increase their utility with the addition of independent software update data and content data by providing new content and new software features and enhancements, therefore, increasing the technological lifespan of the system (*See McFadden*, Abstract, Background and Summary).

8. Claims 10, 18, 24, 44, 53, 55, 56 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,222,925 to Shiels et al. (*Shiels*) and further in view of *McFadden*.

9. With respect to claims 10, 18 and 24, *Shiels* discloses a network (20), a content server 18, a plurality of connected user computers (abstract, 1:39-2:62, 3:20-35, 3:39-60, 8:47-60, figs 1-8), a method of providing an Internet-enabled game, said game including a plurality of episodes related to a storyline arc and made available serially on a periodic basis (abstract, 1:39-2:62, 3:20-35, 3:39-60, 4:40- 8:60, figs 1-8, esp. 7:62-8:2, i.e. on a regular basis), comprising: providing access to an initial episodic content module (5:12-18, 5:49-8:60, ref 70); altering the storyline arc (7:62-8:60, ref 126); creating new episodic content related to the altered storyline arc (7:62-8:60, ref 126); receiving information regarding a user's current state in the game (abstract, 1:39-2:62, 3:20-35, 3:39-60, 4:40-8:60, figs 1-8); responsive to the current state indicating that a conditional action has been performed, enabling new episodic content to be accessed by a user (abstract, 1:39-2:62, 3:20-35, 3:39-60, 4:40-8:60, figs 1-8); and responsive to

the current state indicating that a time is within a predetermined time frame, allowing new episodic content to be automatically transmitted to the user (4:40-8:2, figs 1-8); wherein current state information comprises a user action (4:40-8:46, figs 1-8), wherein an episode is available responsive to determining whether user has submitted payment (4:40-8:2, figs 1-8).

10. However, *Shiels* does not expressly disclose providing access to a technology module for implementing the content module, wherein the technology module can be modified independently from the content module.

11. *McFadden* teaches sending (providing access) and updating software update data (technology module; Figs. 1, 3a/3b – 8, abst, col. 1:5-16; col. 2:20 – 3:25 ), used for playing or operating content data (abst, col. 2:20-3:25), similar to the content module of *Shiels*, that can be sent and updated concurrently or separately (Figs. 1, 3a/3b – 8, abst, col. 1:5-16; col. 2:20 – 3:25, col. 4:65-6:25, col 6:45-58), i.e. independent modification of technology and content modules.

12. Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention to modify computer system of *Shiels* to provide access to independent operational software update data (technology modules) for playing content, as that taught by *McFadden*, for the purpose of updating the client software for operational enhancements (See *McFadden*; abst, col. 2:41-3:25). Because, *McFadden* teaches that content providing systems, like that taught by *Shiels*, increase their utility with the addition of independent software update data and content data by providing new

software features and enhancements, therefore, increasing the technological lifespan of the system (See *McFadden*, Abstract, Background and Summary).

13. With respect to claim 44, *Shiels* discloses a method for providing entertainment content comprising a storyline for an electronic game from the content server to at least one user (supra), the method including steps, implemented in the content server, comprising: receiving a request from a user to gain access to an episode of the electronic game (abstract, 1:39-2:62, 3:20-35, 3:39-60, 4:40-8:46, figs 1-8); delivering an episode of the electronic game to the user (4:40-8:46); determining a date for the request received from the user (abstract, 1:39-2:62, 4:53-8:46); and permitting access to the requested episode responsive to the determined date being within a permitted window for delivery (5:43-8:60, figs 1-8).

14. Further, *Shiels* discloses implementing in the content server an episode into an episodic game module (abst, 1:39-2:62, 3:20-35, 3:39-60, 4:40-8:46, figs 1-8, esp fig. 6 and 7) comprising a content module (abst, 1:39-2:62, 3:20-35, 3:39-60, 4:40-8:46, figs 1-8, esp fig. 6 and 7), however, *Shiels* fails to expressly disclose a technology module for implementing the content module, wherein said technology module can be modified independently from said content module.

15. *McFadden* teaches implementing software update data (technology module; Figs. 1, 3a/3b – 8, abst, col. 1:5-16; col. 2:20 – 3:25 ), used for playing or operating content data (abst, col. 2:20-3:25), similar to the content module of *Shiels*, that can be sent and updated concurrently or separately with content (Figs. 1, 3a/3b – 8, abst, col.



1:5-16; col. 2:20 – 3:25, col. 4:65-6:25, col 6:45-58), i.e. independent modification of technology and content modules.

16. Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention to game module of *Shiels* to include an independent operational software update data (technology module) for playing content, as that taught by *McFadden*, for the purpose of updating the client software for operational enhancements (See *McFadden*; abst, col. 2:41-3:25). Because, *McFadden* teaches that content providing systems, like that taught by *Shiels*, increase their utility with the addition of independent software update data and content data by providing new software features and enhancements, therefore, increasing the technological lifespan of the system (See *McFadden*, Abstract, Background and Summary).

17. With respect to claims 53, 55, 56 and 58, *Shiels* discloses a method (supra) including implementing in the content server the episodes into a sequence of episodic game modules (abstract, 1:39-2:62, 4:40-8:46, figs 1-8, i.e. define nodes/narrative) for each user, transmitting one or more episodic game modules to the user on a conditional basis such that only a portion of the storyline content is currently available to the user (1:39-2:62, 4:53-5:6, 6:17-8:60, figs 1-8); determining whether a time is within a predetermined time frame, and if so, automatically transmitting an episodic game module to the user to ensure that the users access the episodic game module at approximately the same time (4:53-5:6, 6:17-8:60, esp. 6:65-7:2, figs 1-8); and determining whether the user has accomplished a task and if so permitting access to

next episodic game module (supra, i.e. providing payment or PIN/access code, access at particular time/date such as holiday).

18. As stated above, *Shiels* discloses implementing in the content server an episode into an episodic game module (abst, 1:39-2:62, 3:20-35, 3:39-60, 4:40-8:46, figs 1-8, esp fig. 6 and 7) comprising a content module (abst, 1:39-2:62, 3:20-35, 3:39-60, 4:40-8:46, figs 1-8, esp fig. 6 and 7), however, *Shiels* fails to expressly disclose a technology module for implementing the content module, wherein said technology module can be modified independently from said content module.

19. *McFadden* teaches implementing software update data (technology module; Figs. 1, 3a/3b – 8, abst, col. 1:5-16; col. 2:20 – 3:25 ), used for playing or operating content data (abst, col. 2:20-3:25), similar to the content module of *Shiels*, that can be sent and updated concurrently or separately with content (Figs. 1, 3a/3b – 8, abst, col. 1:5-16; col. 2:20 – 3:25, col. 4:65-6:25, col 6:45-58), i.e. independent modification of technology and content modules.

20. Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention to game module of *Shiels* to include an independent operational software update data (technology module) for playing content for similar reasons as those stated with respect to claim 44.

21. Claims 44, 53 and 55-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,102,406 to Miles et al. (*Miles*) and further in view of *McFadden*.

22. With respect to claims 44, 53 and 55-58, where storyline includes scavenger hunt plot, *Miles* discloses a network 22 comprising a content server 20, a plurality of connected user computers 24, a method for providing/delivering [entertainment] content from the content server to at least one user (abstract, 3:26-46, 4:25-6:37, figs 1-6B), including the steps implemented in the content server of receiving a request from a user to game access to an episode of the electronic game (13:48- 15:65), delivering an episode of the electronic game to the user (figs 1-6, esp. 4), determining a date for the request received from the user (15:58-65) and permitting access to the requested episode responsive to the determined date being within permitted window for delivery (9:1- 15:65); implementing in the content server the storyline content into a plurality of episodes (abstract, 3:26-46, 4:25-6:37, figs 3-6B esp. 4), implementing the episodes into a sequence of episodic game modules (figs 3-6B), for each user transmitting one or more game modules to user's computer on a conditional basis such that the plurality of users reach the same points in the game at approximately same time (figs 3-6B).

23. Further, *Miles* discloses implementing in the content server an episode (figs. 3-6B) into an episodic game module (figs. 3-6B) comprising a content module (figs. 3-6B), however, *Miles* does not expressly disclose a technology module for implementing the content module, wherein said technology module can be modified independently from said content module.

24. *McFadden* teaches implementing software update data (technology module; Figs. 1, 3a/3b – 8, abst. col. 1:5-16; col. 2:20 – 3:25 ), used for playing or operating content data (abst. col. 2:20-3:25), similar to the content module of *Miles*, that can be

sent and updated concurrently or separately with content (Figs. 1, 3a/3b – 8, abst, col. 1:5-16; col. 2:20 – 3:25, col. 4:65-6:25, col 6:45-58), i.e. independent modification of technology and content modules.

25. Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention to game module of *Miles* to include an independent operational software update data (technology module) for playing content, as that taught by *McFadden*, for the purpose of updating the client software for operational enhancements (*See McFadden*; abst, col. 2:41-3:25). Because, *McFadden* teaches that content providing systems, like that taught by *Miles*, increase their utility with the addition of independent software update data and content data by providing new software features and enhancements, therefore, increasing the technological lifespan of the system (*See McFadden*, Abstract, Background and Summary).

26. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over US *Sinclair* in view of *McFadden*, as applied to claim 1 above, and further in view of in view of *Miles* or *Shiels*.

27. The modified Sinclair reference discloses a method comprising claimed features (supra), however, does not expressly disclose scheduling intervals for generation and transmission of episodic game modules for the complete storyline content. In related references, *Miles* (15:63-65) and *Shiels* (7:62-8:41) disclose a method teaching scheduling intervals for generation and transmission of episodic game modules for the complete storyline content. *Miles* and *Shiels* is relevant prior art either for being in the

field of applicant's endeavor or, for being reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill is as represented by cited references. Because Miles, Shiels and the modified Sinclair reference each regard method of game play on a gaming machine to provide content incrementally as episodes or segments, in consideration of KSR, it would have been obvious to an artisan at a time prior to invention to apply the process of scheduling intervals for generation and transmission of episodic game modules for the complete storyline content as taught by either Miles or Shiels to improve the method of Sinclair to yield the predictable result of general scheduling manufacture of incremental episodes so as to gain a following of interested users.

28. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sinclair in view of *McFadden*, in further view of Miles or Shiels, as applied to claim 2 above, and further in view of background prior art.

29. As would have been interpreted by an artisan, the modified Sinclair reference discloses the method (*supra*) but lacks discussing responsive to a technological improvement occurring during a first part of an interval for generation and transmission of an episodic module incorporating the technological improvement into the episodic game module scheduled for generation and transmission for that interval (clm 3) and responsive to a technological improvement occurring during a implementation of an episode incorporating the technological improvement into the episodic game module

scheduled for generation and transmission for that interval (clm 4). However, the instant background discussion of related prior art (1 : 11-2:9, 7:1-22, fig 1) teaches responsive to a technological improvement occurring during a first part of an interval for generation and transmission of an episodic module incorporating the technological improvement into the episodic game module scheduled for generation and transmission for that interval and responsive to a technological improvement occurring during a implementation of an episode incorporating the technological improvement into the episodic game module scheduled for generation and transmission for that interval by happenstance of timing when an improvement is available. It is also noteworthy that by happenstance of a business decision to delay production so as to incorporate a technological improvement further demonstrates such process being suggested. The background admitted prior art is relevant prior art either for being in the field of applicant's endeavor or, for being reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill is as represented by cited references. Because the background prior art and modified Sinclair reference each regard method of game play on a gaming machine to provide content incrementally as episodes, in consideration of KSR, it would have been obvious to an artisan at a time prior to invention to apply the process of responsive to a technological improvement occurring during a first part of an interval for generation and transmission of an episodic module incorporating the technological improvement into the episodic game module scheduled for generation and

transmission for that interval and responsive to a technological improvement occurring during a implementation of an episode incorporating the technological improvement into the episodic game module scheduled for generation and transmission for that interval as suggested by background prior art to improve the method of the modified Sinclair reference to yield the predictable result of incorporating an improvement as it becomes available or to render business decision to delay to incorporate it.

30. Claim 8-9 are rejected under 35 U.S.C. 103(a) as unpatentable over Sinclair in view of *McFadden*, as applied to claim 7 above, and in further view of *Miles* or *Shiels*.

31. As best understood by an artisan, the modified Sinclair reference discloses a method comprising claimed features (*supra*) but lacks periodically scheduled intervals (clm 8) and monthly (clm 9). In related references, as evidence stated above, Miles and Shiels disclose a method teaching periodically scheduled intervals and monthly. Miles and Shiels remain relevant prior art and level of ordinary skill remains as shown by references. Because Miles, Shiels and the modified Sinclair reference each regard method of game play on a gaming machine to provide content incrementally as episodes or segments, in consideration of KSR, it would have been obvious to an artisan at a time prior to invention to apply the process of periodically scheduled intervals and monthly as taught by either Miles or Shiels to improve the method of the modified Sinclair reference to yield the predictable result of scheduling transmittal of episodes so as to gain a following of interested users. The particular interval is not a patentable distinction that critically defines over combination of references.

32. Claims 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiels, in view of McFadden, as applied to claim 10 above, and further in view of Eichstaedt or Sinclair.

33. In summary, the modified Shiels reference discloses claimed method (*supra*) but lacks voice message. In related references, Eichstaedt (2:31-34) and Sinclair (16:15-19:43) discloses a method teaching a network transport mechanism of voice mail to deliver content. Eichstaedt and Sinclair is relevant prior art either for being in the field of applicant's endeavor or, for being reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill is as represented by cited references. Because Eichstaedt, Shiels, McFadden and Sinclair each regard method of transmitting content over a network to a computer, in consideration of KSR, it would have been obvious to an artisan at a time prior to invention to apply the process of voice mail as taught by Sinclair or Eichstaedt to improve the method of the modified Shiels reference to yield the predictable result of delivering content to user. Essentially, the particular mechanism to provide content fails to critically distinguish over the combination when taken as a whole at time prior to invention.



34. Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiels, in view of McFadden, as applied to claim 10 above, and in further view of Eichstaedt (6381594) or Miles (6102406).

35. In summary, the modified Shiels reference discloses claimed method (*supra*) but lacks email message. In related references, Eichstaedt (2:31-34) and Miles (6:17-20) discloses a method teaching a network transport mechanism of email message to deliver content. Eichstaedt and Miles is relevant prior art either for being in the field of applicant's endeavor or, for being reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill is as represented by cited references. Because the Eichstaedt, Miles and the modified Shiels reference each regard method of transmitting content over a network to a computer, in consideration of KSR, it would have been obvious to an artisan at a time prior to invention to apply the process of email as taught by Eichstaedt or Miles to improve the method of the modified Shiels reference to yield the predictable result of delivering content to user. Essentially, the particular mechanism to provide content fails to critically distinguish over the combination when taken as a whole at time prior to invention.

36. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiels in view of McFadden, as applied to claim 10 above, and further in view of Wicks (5942969).

37. In summary, the modified Shiels reference discloses claimed method (*supra*) but lacks voice message. In related reference, Wicks (ref 21) discloses a method teaching a network transport mechanism of pager. Wicks is relevant prior art either for being in the field of applicant's endeavor or, for being reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill is as represented by cited references. Because Wicks and the modified Sinclair reference each regard method of transmitting content over a network between server and a computer, in consideration of KSR, it would have been obvious to an artisan at a time prior to invention to apply the process of pager as taught by Wicks to improve the method of the modified Shiels reference to yield the predictable result of delivering content to user. Essentially, the particular mechanism to provide content fails to critically distinguish over the combination when taken as a whole at time prior to invention.

38. Claims 17 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiels, in view of McFadden, as applied to claim 10 above, and further in view of Miles (6102406).

39. In summary, the modified Shiels reference discloses claimed method (*supra*) but lacks a notification from an application module resident on a user's terminal that the user accessed a pre-specified web page (clm 17), accessing a predetermined web site (clm 20), requesting a specific search term (clm 21), wherein episodic content is stored

within a third party website that is content related to the storyline and the users are directed to the website to discover the episodic content (clm 22) and wherein episodic content is placed on third party web site for compensation related to user traffic to the web site related to users searching for the episodic content (clm 23). In a related reference, where notification is at least a cookie, where advertisers/sponsors are third party and where hypertext link accesses a website, Miles (abstract, 3:26-46, 4:26-5:7, 5:51-11:7, 11:35-60, 12:41-15:65, figs 1-6B, esp. 3-6B) discloses a method (supra) teaching a notification from an application module resident on a user's terminal that the user accessed a pre-specified web page (7:1-8:63); wherein the user action is accessing a predetermined web site (9:1-12:29, 12:41-15:65, figs 3-6B); wherein the user action is requesting a specific search term (abstract, 3:26-46, 4:26-5:7, 5:51-8:63, 9:1-12:29, 12:41-15:65, figs 3-6B, i.e. searching via search engine and/or use of "FIND ON PAGE" utility on a website inherent in browser such as Internet Explorer to locate query); wherein episodic content is stored within a third party website that is content related to the storyline (abstract, 3:26-46, 4:26-5:7, 5:51-8:63, 9:1-12:29, 12:41-15:65, figs 3-6B) and the users are directed to the website to discover the episodic content and wherein episodic content is placed on third party web site for compensation related to user traffic to the web site related to users searching for the episodic content (abstract, 3:26-46, 4:26-5:7, 5:51-8:63, 9:1-12:29, 12:41-15:65, figs 3-6B). Miles is relevant prior art either for being in the field of applicant's endeavor or, for being reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443,

24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill is as represented by cited references. Because the Miles and the modified Shiels reference each regard method of transmitting content over a network to a computer where user performs action to advance game, in consideration of KSR, it would have been obvious to an artisan at a time prior to invention to apply the process of a notification from an application module resident on a user's terminal that the user accessed a pre-specified web page, accessing a predetermined web site, requesting a specific search term, wherein episodic content is stored within a third party website that is content related to the storyline and the users are directed to the website to discover the episodic content and wherein episodic content is placed on third party web site for compensation related to user traffic to the web site related to users searching for the episodic content as taught by Miles to improve the method of the modified Shiels reference to yield the predictable result of delivering content to user upon user action and to generate revenue stream based on users interactions at predefined websites.

40. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiels in view of McFadden, as applied to claims 10 and 18, further in view of Forrest (5697075).

41. In summary, the modified Shiels reference discloses claimed method (*supra*) but lacks wherein the user action is calling a predefined telephone number. In a related reference, Forrest (abstract, 2:27-3:35, 3:58-4:28, 11:53-58, figs 1-5) discloses a method teaching wherein the user action is calling a predefined telephone number. Forrest is relevant prior art either for being in the field of applicant's endeavor or, for

being reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill is as represented by cited references. Because the Forrest and the modified Shields reference each regard method of delivering content based on user action, in consideration of KSR, it would have been obvious to an artisan at a time prior to invention to apply the process of calling a predefined telephone number as taught by Forrest to improve the method of the modified Shields reference to yield the predictable result of delivering content to user. Essentially, the particular mechanism to provide content fails to critically distinguish over the combination when taken as a whole at time prior to invention.

42. Claim 48 is rejected under 35 U.S.C. 103(a) as obvious over Sinclair, in view of McFadden, as applied to claim 1 above, and further in view of Miles.

43. The modified Sinclair reference discloses the method (supra), Sinclair lacks wherein the reference is a fabricated news story related to real world events, the particular manner of delivering/providing real world event fails to critically distinguish over the modified Sinclair reference where fabricated news story is a form of presentation that regards design choice. In a related reference, Miles discloses a method (supra) teaching providing/transmitting episodes to users who access websites in response to clues to advance game where the information on the websites of sponsors is current world event thereby suggesting a fabricated news story in so far as

the content on website relates to storyline of game. Miles remains relevant prior art and level of skill remains as stated above. In consideration of KSR, it would have been obvious to an artisan at a time prior to the invention to apply wherein the reference is a fabricated news story related to real world events as suggested by Miles to improve the method of the modified Sinclair reference to yield the predictable result of presenting real world content to user in an episode of game. In essence, the manner of presentation fails to critically distinguish over combination when taken as a whole at a time prior to the invention.

### ***Response to Arguments***

44. Applicant's arguments, see page 10, filed 11/15/2010, with respect to the 35 U.S.C. 112 first paragraph enablement issue have been fully considered and are persuasive. The rejection of claims 1-4, 6-13, 17-24 and 53-58 has been withdrawn.
45. Applicant's arguments, see page 10, filed 11/15/2010, with respect to indefinite claim language have been fully considered and are persuasive. The rejection of claims 1-4, 6-9, 42-43 and 47-58 has been withdrawn.
46. Applicant's arguments with respect to claims 1-4, 7-13, 17-24, 42-44, 47-53 and 55-58 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW RUSSELL whose telephone number is

(571)270-3472. The examiner can normally be reached on Monday thru Friday, 8AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. R./  
Examiner, Art Unit 3716

/Dmitry. Suhol/  
Supervisory Patent Examiner, Art  
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